UNITED STATES PATENT AND TRADEMARK OFFICE

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10/065,527	10/25/2002	Carl Michael Dennison	BLD920010034US2	2144

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NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

BILL@CWPETERSON.COM
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	Application No.	Applicant(s)
Office Action Summary	10/065,527	DENNISON ET AL.
	Examiner	Art Unit	
	PETER K. HUNTSINGER	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 4/27/11 have been fully considered but they are not

persuasive.

The Applicant argues on pages 8-10 of the response in essence that:

Inserting visual feedback directly into the source document requires inserting that

visual feedback into the file in memory for subsequently storing it because editing a file

of a document viewing application requires inserting mark-up commands into the file.

a.   While the Applicant's original disclosure on pages 3-4, paragraph 14

states that "the plug-ins of the present invention insert visual feedback directly

into the source document", this statement does not expressly, implicitly, or

inherently support that visual cue objects or visual feedback are inserted into the

file. Inserting visual feedback directly into the source document is not equivalent

to inserting visual feedback into the file because visual feedback could be

overlaid directly into the source document without storing the feedback into the

file. When an explicit limitation in a claim "is not present in the written description

whose benefit is sought it must be shown that a person of ordinary skill would

have understood, at the time the patent application was filed, that the description

requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353 (Fed. Cir. 1998).

The Applicant has not shown that inserting feedback into the file is required from

the original disclosure, and not just mere possibility.

The Applicant argues on pages 10 and 11 of the response in essence that:

Because the visual cue objects are removed before the document is to be

printed, the print job ticket is created when markers are removed.

b.   The Applicant's original disclosure does not describe at what point a job

ticket is created before printing (i.e. before markers are removed or after).

Therefore, this statement does not expressly, implicitly, or inherently support that

the print job ticket is created when markers are removed.

The Applicant argues on pages 11 and 12 of the response in essence that:

The user interface of Livingston '454 is not a document viewing application that

modifies print job parameters.

c.   The GUI of Livingston '454 can be considered a document viewing

application because it is a program that displays a document (Figs. 3A and B,

col. 1-2, lines 56-67, 1-10). Livingston '454 also discloses that the print preview

image 68 shows the selected image as it will appear when it is printed [i.e.

selected print settings applied by the GUI are applied to the printed document]

(col. 5, lines 38-53).

The Applicant argues on page 12 of the response in essence that:

The cited prior art fails to disclose that the document viewing application provides

access to all features while the plug-ins are active in said document viewing application.

d.   Hansen '820 discloses that the main program code is designed to look for

small enhancement programs (" plug ins") each time the code is executed. If one

or more plug ins are found, their functionality is incorporated into the main

program code [i.e. providing access to all feature] through a plug in interface (col.

13, lines 20-49).

The Applicant argues on page 13 of the response in essence that:

The cited prior art fails to disclose that the document viewing application provides

access to all features while the plug-ins are active in said document viewing application.

e.   Hansen '820 discloses that the viewer component 306 ("viewer") provides

the functionality for viewing documents and pages within documents and

preferably operates on documents formatted in a ready for printer format. Further

the viewer 306 provides the ability to assemble, edit and annotate at the page

level of the document as well as set page features for individual or groups of

pages (col. 13, lines 50-67, 1-13)

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4.   Claim 1 recites "inserting visual feedback into the file in memory." The Applicant's original disclosure fails to describe that visual cue objects or visual feedback is inserted into the file as opposed to inserting the visual cue objects or visual feedback into the document image. While the Applicant's original disclosure on pages 3-4, paragraph 14 states that "the plug-ins of the present invention insert visual feedback directly into the source document", this statement does not expressly, implicitly, or inherently support that visual cue objects or visual feedback are inserted into the file. Claim 9 includes similar limitations.

5.   Claim 2 recites "said document viewing application provides access to all features while the plug-ins are active in said document viewing application." The Applicant's original disclosure fails to describe accessing all features or the plug-ins becoming active.

6.   Claim 5 includes limitations for inserting visual cue objects in said file and removing visual cue objects from said file. The Applicant's original disclosure fails to describe inserting or removing visual cue objects from a file. Claim 13 includes similar limitations.

7.   Claim 6 recites "said print job ticket is created when the markers are removed." The Applicant's original disclosure fails to describe creating a print job ticket when markers are removed. Claim 14 includes similar limitations.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1, 3-9 and 11-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Livingston Patent 6,614,454, and further in view of Lahey Patent

5,999,945 and Hansen Patent 6,407,820.

        Referring to **claims 1 and 9**, Livingston '454 discloses a method comprising:

        opening a document viewing application (Figs. 3A and B, col. 1-2, lines 56-67, 1-

10);

        opening an original document in said document viewing application, said original

document being in a file in memory (col. 2, lines 11-36, the computer implemented

printer control system includes memory configured to provide an operating system and

operative to store files representing at least one document to be printed);

        displaying said original document (col. 5, lines 38-53, print preview image 68 of

Fig. 3A shows placement of the three staples 69); and within said document viewing

application

        inserting into the original document display a plurality of visual cue objects

corresponding to print job parameters in said original document, the display indicating

application of said print job parameters to said original document (col. 5, lines 38-53,

print preview image 68 of Fig. 3A shows placement of the three staples 69),

inserting visual feedback into the file in memory, inserting said visual feedback

responsive to user interactions to amend said original document, indicating changes by

visual cue objects displayed, wherein including said changes in said file creates an

amended document (col. 5, lines 6-53, when a user selects "Staple this Job Using" in

Fig. 3A, the print preview image 68 shows the selected page as it will appear when it is

printed),

removing said visual feedback from the amended document (col. 5, lines 6-27,

when a user deselects "Staple this Job Using" in Fig. 3A, the staples displayed on print

preview image 68 will be removed), any corresponding changes to said print job

parameters are included in print job settings for the amended document, removing said

visual feedback responsive to performing specific operations (col. 5, lines 38-53, the

print preview image 68 shows the selected image as it will appear when it is printed [i.e.

selected print settings are applied to the printed document]).

Livingston '454 does not disclose expressly printing the amended document

responsive to a print job ticket.

Lahey '945 discloses print job ticketing parameters (col. 5, lines 46-50, the job

ticket maintains information on print attributes of the print job);

forwarding said amended document and said print job ticket to a printer (col. 8-9

lines 61-67, 1-13, the user can submit the job ticket to the InfoPrint MPC server 6 for

printing); and

printing said amended document responsive to said print job ticket (col. 5, lines

46-50, the job ticket maintains information on print attributes and the location of the print

files which comprise the print jobs).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to utilize a job ticket to store print settings. The motivation for doing so would

have been to efficiently store print settings in a widely used format.

Livingston '454 does not disclose expressly including in the document viewing

application a visual job ticketing plug-in.

Hansen '820 discloses including in the document viewing application at least one

visual job ticketing plug-in providing a visual job ticketing interface (col. 13, lines 20-49,

the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines 28-61,

print tickets are independently are independently visually represented on the display by

the workflow management software).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to provide a job ticketing plug-in in a document viewing application. The

motivation for doing so would have been to allow enhancements and updates to be

incorporated into the viewing application in a simple and efficient manner and without

requiring recompilation of the main program code which implements the viewing

application. Therefore, it would have been obvious to combine Lahey '945 and Hansen

'820 with Livingston '454 to obtain the invention as specified in claims 1 and 9.

Referring to **claims 3 and 11**, Livingston '454 discloses wherein the specific

operation is initiating a print from said document viewing application ("Print" of Fig. 3A,

col. 5, lines 17-20).

Lahey '945 discloses said print job being created responsive to initiating (col. 8-9

lines 61-67, 1-13, the user can submit the job ticket to the InfoPrint MPC server 6 for

printing).

Hansen '820 discloses said at least one visual job ticketing plug-in (col. 13, lines

20-49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines

28-61, print tickets are independently are independently visually represented on the

display by the workflow management software).

Referring to **claims 4 and 12**, Livingston '454 discloses wherein said step of

inserting visual cues objects further includes inserting a marker to each of the plurality

of visual cue objects, each said marker not being displayed, and wherein said step of

removing said visual feedback further includes locating and removing markers in said

file (col. 5, lines 38-53, print preview image 68 of Fig. 3A shows placement of the three

staples 69 [It is inherent that the program of Livingston needs to track of whether the

option for staples has been selected or not. A register or variable present in the

program code indicates the selection of the user and is and unseen marker. The

selection or deselection of the "Staple this Job Using" button would require locating the

register or variable to record the result.]).

Hansen '820 discloses said at least one visual job ticketing plug-in (col. 13, lines

20-49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines

28-61, print tickets are independently are independently visually represented on the display by the workflow management software).

Referring to **claims 5 and 13**, Livingston '454 discloses wherein said step of inserting visual cues objects further includes maintaining a list of markers to each of the plurality of visual cue objects inserted in said file (col. 5, lines 20-27, as is shown in Fig. 3A of Livingston, the option of stapling is provided sequentially is a list format. The user is able to visible view the list and determine which staples that are desired to be removed) and wherein said step of removing said visual feedback further includes referencing the list and identifying the markers to the plurality of visual cue objects to be removed from said file (col. 5, lines 6-27, when a user deselects "Staple this Job Using" in Fig. 3A, the staples displayed on print preview image 68 will be removed).

Hansen '820 discloses said at least one visual job ticketing plug-in (col. 13, lines 20-49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines 28-61, print tickets are independently are independently visually represented on the display by the workflow management software).

Referring to **claims 6 and 14**, Livingston '454 discloses wherein said document viewing application is a document editor, said visual feedback includes feedback for document edits (Figs. 3A and B, col. 1-2, lines 56-67, 1-10).

Hansen '820 discloses wherein said at least one visual job ticketing plug-in is a set of visual job ticketing plug-ins (col. 13, lines 20-49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines 28-61, print tickets are independently

are independently visually represented on the display by the workflow management

software).

Lahey '945 discloses creating said print job ticket when the markers are removed

(col. 8-9 lines 61-67, 1-13, the user can submit the job ticket to the InfoPrint MPC server

6 for printing).

Referring to **claims 7 and 15**, Livingston '454 discloses applying certain of the

print job ticketing parameters to all pages of the document file responsive to said

interactions ("Apply changes to: All Pages" of Fig. 3B).

Hansen '820 discloses said set of visual job ticketing plug-ins (col. 13, lines 20-

49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines 28-

61, print tickets are independently are independently visually represented on the display

by the workflow management software).

Referring to **claims 8 and 16**, Livingston '454 discloses applying certain of the

print job ticketing parameters to selected pages of the document file responsive to said

interactions ("Apply changes to: All Pages" of Fig. 3B, The changes are shown to apply

to selecting all pages).

Hansen '820 discloses said set of visual job ticketing plug-ins (col. 13, lines 20-

49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines 28-

61, print tickets are independently are independently visually represented on the display

by the workflow management software).

10.   Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Livingston U.S. Patent 6,614,454, Lahey Patent 5,999,945 and Hansen Patent

6,407,820 as applied to claim 1 above, and further in view of Moore U.S. Patent

6,880,124.

Referring to **claims 2 and 10**, Livingston '454 discloses removing from the

amended document, for printing to be performed on the amended document, at least

one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and

performing the printing ("Print" of Fig. 3A, col. 5, lines 17-20). When the user prints the

document, the staples displayed on print preview image 68 showing where the staples

will appear are not be printed and must be removed prior to printing.

Hansen '820 discloses said document viewing application provides access to all

features while the plug-ins are active in said document viewing application (col. 13, lines

20-49, the main program code is designed to look for small enhancement programs ("

plug ins") each time the code is executed. If one or more plug ins are found, their

functionality is incorporated into the main program code [i.e. providing access to all

feature] through a plug in interface).

Livingston '454 does not disclose expressly the specific operation of saving.

Moore '124 discloses wherein the specific operation is a save operation saving

said amended document to storage for subsequent forwarding to print (col. 7, lines 12-

18, can be configured to automatically save the communication to a database when the

communication is printed).

At the time of the invention, it would have been obvious for a person of ordinary

skill in the art to automatically save a document when printing. The motivation for doing

so would have been to create a backup file for printed documents in case the user's file

is not printed correctly or further copies are desired. Therefore, it would have been

obvious to combine Moore '124 with Livingston '454 to obtain the invention as specified

in claims 2 and 10.

11.   Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Livingston U.S. Patent 6,614,454, Lahey Patent 5,999,945 and Hansen Patent

6,407,820 as applied to claims 1 and 9 above, and further in view of Koppolu Patent

6,268,924.

Referring to **claim 17**, Livingston '454 discloses wherein said step of inserting

visual cue objects further includes displaying the plurality of visual cue objects, but does

not disclose expressly wherein said document viewing application is a word processor.

Hansen '820 discloses wherein said document viewing application is a word

processor (col. 13, lines 50-67, 1-13, the viewer component 306 ("viewer") provides the

functionality for viewing documents and pages within documents and preferably

operates on documents formatted in a ready for printer format. Further the viewer 306

provides the ability to assemble, edit and annotate at the page level of the document as

well as set page features for individual or groups of pages).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to provide a job ticketing plug-in for a word processor. The motivation for doing

so would have been to allow enhancements and updates to be incorporated into the word processer in a simple and efficient manner and without requiring recompilation of the main program code which implements the viewing application.

Livingston '454 does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard format well known in the art. Therefore, it would have been obvious to combine Hansen '820 and Koppolu '924 with Livingston '454 to obtain the invention as specified in claim 17.

Referring to **claim 19**, Livingston '454 discloses wherein said step of inserting visual cue objects further includes displaying the plurality of visual cue objects, but does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard format well known in the art. Therefore, it would have been obvious to combine Koppolu et al. with Livingston '454 to obtain the invention as specified in claim 19.

12.   Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Livingston U.S. Patent 6,614,454, Lahey Patent 5,999,945 and Hansen Patent

6,407,820 as applied to claims 6 and 19 above, and further in view of Koppolu Patent

6,268,924.

Referring to **claims 18 and 20**, Livingston '454 discloses wherein said step of

inserting visual cue objects further includes displaying the plurality of visual cue objects,

and monitoring the print preview for the current page selection (col. 5, lines 39-44).

Hansen '820 discloses said at least one visual job ticketing plug-in (col. 13, lines

20-49, the desktop 302 is preferably structured as a plug in architecture) (col. 12, lines

28-61, print tickets are independently are independently visually represented on the

display by the workflow management software).

Livingston '454 does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for

doing so would have been to utilize a space saving image format. Further, a thumbnail

file is standard format well known in the art. Therefore, it would have been obvious to

combine Koppolu '924 with Livingston '454 to obtain the invention as specified in claims

18 and 20.

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to PETER K. HUNTSINGER whose telephone number is

(571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on (571)272-7437. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PETER K HUNTSINGER/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625